REMARKS

Claims 1, 2, 4-10, 12-28, 30-36, 38-49 and 51-56 are currently pending in the present application. Claims 12, 38, 55 and 56 have been allowed. The remaining claims stand rejected. In this regard, Claims 1, 2, 4-10, 13-28, 30-36, 39-49 and 51-54 have been rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 5,864,868 to David C. Contois in view of U.S. Patent No. 6,301,586 to Yang et al. As described below in detail, Applicants respectfully submit that the Examiner prematurely issued a final Official Action due to the introduction of the new ground of rejection of elements of Claims 1-21 in view of the Yang '586 patent. As also described below, independent Claims 1, 17, 25, 27, 43, 51 and 53 are patentably distinct from the cited references, taken either individually or in combination. Nonetheless, Applicants have amended dependent Claims 18 and 44 to correct an inadvertent typographical error, more particularly amending "said first multimedia object" to read "said first multimedia data item." As this amendment merely addresses a typographical error, the amendment does not raise new issues and should be substantively considered. As a result of the amendments to the claims and the following remarks, Applicants respectfully request reconsideration of the present application and allowance of the pending set of claims, or in lieu thereof at least withdrawal of the finality of the October 18, 2005 Official Action.

As background and for purposes of discussion, independent Claim 1 recites a method executed in a computer system for selecting a multimedia presentation that includes: (i) providing a plurality of multimedia presentations in accordance with predetermined criteria, (ii) providing one or more multimedia data items with each of the multimedia data items being a duplicate of a portion of a corresponding one of the plurality of multimedia presentations, (iii) presenting one or more multimedia data items using a browser with the multimedia data items being presented separately from the plurality of multimedia presentations, (iv) controlling the direction and speed of the presentation of the multimedia data items, (v) selecting a first one of the multimedia data items and (vi) transferring control to machine executable code associated with a first one of the multimedia presentations corresponding to the first multimedia data item for display of the first multimedia presentation. As further recited, the first multimedia

presentation includes additional portions that differ from and do not include the portion duplicated by the first multimedia data item.

I. FINALITY OF THE OFFICIAL ACTION IS PREMATURE

In the Official Action dated April 6, 2005, the Examiner rejected Claims 1, 2, 4-10, 13-28, 30-36, 39-49 and 51-54 under 35 USC § 103(a) as being unpatentable over the Contois '868 patent in view of U.S. Patent No. 6,529,920 to Barry M. Arons et al. and in further view of U.S. Patent No. 6,505,171 to Robert H. Cohen et al. As to independent Claim 1, and similarly independent Claims 17, 25, 27, 43, 51 and 53, the Official Action alleged that the Contois '868 patent disclosed all of the aforementioned features except providing multimedia data items that are a duplicate of a portion of a corresponding one of the plurality of multimedia presentations, and controlling the speed of presenting multimedia data items. The Official Action alleged that the Cohen '171 patent and the Arons '920 patent, respectively, disclosed those features of the claimed invention, and that it would have been obvious to one skilled in the art to combine the teachings of the Contois '868, Cohen '171 and Arons '920 patents to disclose the claimed invention. In response, Applicants traversed the rejections of the claims, but nonetheless amended independent Claims 1, 17, 25, 27, 43, 51 and 53 to further clarify the claimed invention by reciting that the selected first multimedia presentation includes additional portions that differ from and do not include the portion duplicated by the first multimedia data item.

Now, in the final Official Action, the Examiner again rejects 1, 2, 4-10, 13-28, 30-36, 39-49 and 51-54 under 35 USC § 103(a). In contrast to the Official Action of April 6, 2005, however, the Examiner now alleges that the claimed invention is unpatentable over the Contois '868 patent in view of the Yang '586 patent. More particularly, the Examiner again concedes that the Contois '868 patent does not disclose providing multimedia data items that are a duplicate of a portion of a corresponding one of the plurality of multimedia presentations, and controlling the speed of presenting multimedia data items. Instead of citing the Contois '868, Cohen '171 and Arons '920 patents for these features, however, the Examiner now alleges that the Yang '586 patent discloses both features.

In accordance with MPEP § 706.07(a), a second or subsequent Official Action shall be made final, "except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR § 1.97(c) with the fee set forth in 37 CFR § 1.17(p)." In the instant case, by alleging that the newly cited Yang '586 patent discloses the claimed feature of controlling the speed of presenting multimedia data items, the Examiner has introduced a new ground of rejection neither necessitated by Applicants' claim amendments presented in response to the Official Action of April 6, 2005, nor based on information submitted in an IDS filed after that Official Action. In this regard, independent Claims 1, 17, 25, 27, 43, 51 and 53 include the feature of controlling the speed of presenting multimedia data items is in the same form as it appeared in those claims when the Examiner issued the Official Action of April 6, 2005. Now, in the current final Official Action, the Examiner no longer alleges that the Arons '920 patent discloses this feature, but instead alleges that the feature is disclosed by the newly cited Yang '586 patent.

In response to the Official Action of April 6, 2005, Applicants amended independent Claims 1, 17, 25, 27, 43, 51 and 53 with respect to a selected first multimedia presentation, but did not amend those claims with respect to controlling the speed of presenting multimedia data items. In fact, Applicants traversed the alleged combination of the Contois '868 patent and the Arons '920 patent for disclosing this feature of the claimed invention. Thus, Applicant respectfully submits that the Examiner did not introduce the new ground of rejection with respect to the speed-controlling feature for any reason necessitated by Applicant's amendment of independent Claims 1, 17, 25, 27, 43, 51 and 53 with respect to the selected first multimedia presentation. Further, Applicant has not filed an information disclosure statement since before mailing of the first Official Action of this application on May 5, 2003. Thus, Applicant also respectfully submits that the Examiner did not introduce the new ground of rejection of at least the aforementioned speed-controlling feature for any reason necessitated by Applicants filing of an information disclosure statement during the period following mailing the mailing of such as first Official Action, as would be during the period set forth in 37 CFR § 1.97(c).

Applicant therefore respectfully submits that in the current Official Action, the Examiner introduced a new ground of rejection that was neither necessitated by Applicant's amendment of independent Claims 1, 17, 25, 27, 43, 51 and 53 nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR § 1.97(c). Applicant also respectfully submits that, in accordance with MPEP § 706.07(a), the Examiner prematurely issued a final Official Action. Accordingly, Applicant respectfully requests withdrawal of the finality of the current Official Action.

II. THE CLAIMS OF THE PRESENT APPLICATION ARE PATENTABLE

As indicated above, the Official Action rejects Claims 1-21 under 35 U.S.C. § 112, second paragraph, and also rejects Claims 1, 2, 4-10, 13-28, 30-36, 39-49 and 51-54 as being unpatentable over the Contois '868 patent in view of the Yang '586 patent. As explained in response to the Official Action of April 6, 2005, the Contois '868 patent is directed to a system and method for controlling a media playing device in which a user interacts with various data fields that are displayed on a computer screen to choose music or video selections from a media database. The computer screen also displays various media playback buttons to allow the user to control the playback of the music or video selections. In instances in which a user selects a particular item from one of the data fields, the remaining data fields are configured so as to display only the items found in the music database that are directly related to the selected item. Selecting the music category "classical" from the listed items in the "categories" data field, for example, results in only data items relating to classical music being displayed. As described by the Contois '868 patent, a user therefore makes an interactive selection of one or more of the displayed items in a data field so as to result in the automatic display of related items in the other data fields. The user can thereafter further select data items from the resultant listing of data items to achieve an even more refined listing of available data items. Once a user finally finds, through the interactive process, the music or video selection it wishes to access, the user may start playing that selection.

The Yang '586 patent discloses a system for managing multimedia objects such as text, images, sound, and video clips. As disclosed, the system provides organization of multimedia

objects through use of albums organized into collections of albums. The system includes a user interface that permits albums that can be opened in a thumbnail view presenting thumbnail images of the items of an album, a notebook view that additionally provides database information for those items, and a spreadsheet view that just presents text information for the items of an album. In addition, the system includes a slide show component whereby the items of an album may be sequentially viewed in a slideshow manner, the component including control options for special effects applied to the items, an adjustable slide show speed, audio annotation of the slide show, and a number of other selectable options including repeat, stop, re-size image or the like.

In contrast to independent Claim 1, neither the Contois '868 patent nor the Yang '586 patent, taken individually or in combination, teach or suggest controlling the direction and speed of the presentation of multimedia data items in a method also including providing a plurality of multimedia presentations and one or more data items, whereby each of the multimedia data items is a duplicate of a portion of a corresponding one of the multimedia presentations. Further, even if the respective patents did disclose those features as alleged by the Official Action, one skilled in the art would not have been motivated to combine their teachings to disclose the claimed invention.

A. Controlling the Direction of Presentation of Multimedia Data Items

The Official Action alleges that the Contois '868 patent discloses providing a plurality of multimedia presentations and one or more data items, and controlling the direction of presentation of multimedia data items. As support, the Official Action asserts that the music or other media information selected via the user interface of the Contois '868 patent corresponds to the recited multimedia presentations, and appears to assert that either the listings presented under the different headings, or the graphics presented in a graphics window, during selection of music/media information correspond to the recited multimedia data items. Presume for the sake of explanation (and expressly not admitted as such) that the disclosed music/media information accurately corresponds to the recited multimedia presentations, and that either the disclosed listings or graphics accurately correspond to the recited multimedia data items. The Official

Action then asserts that the disclosed media device control buttons (play, rewind, pause, stop) correspond to the recited feature of controlling the direction of presentation of multimedia data items. As clearly disclosed by the Contois '868 patent, however, the media device control buttons control playback of a selected piece of music/media information (multimedia presentation), and not presentation of listings or graphics (multimedia data item) associated with the selected piece of music/media information. Thus, whereas one could argue that the Contois '868 patent discloses controlling the direction of presentation of a multimedia presentation (music/media information), nowhere does the Contois '868 patent teach or suggest controlling the direction of presentation of multimedia data items (listings or graphics presented during selection of music/media information), similar to the claimed invention.

B. Controlling the Speed of Presentation of Multimedia Data Items

As conceded in the Official Action, the Contois '868 patent does not disclose controlling the speed of presentation of the data items. Nonetheless, the Official Action alleges that the newly cited Yang '586 patent discloses this feature, and that it would have been obvious to one skilled in the art to combine the teachings of the Contois '868 and Yang '586 patents to disclose the claimed invention. Applicants respectfully submit, however, that like the Contois '868 patent, the Yang '586 patent likewise does not teach or suggest controlling the speed of presentation of data items. As indicated above, the Yang '586 patent does disclose sequentially viewing items of an album in a slideshow manner, and including an adjustable slide show speed. As most readily analogous to the claimed invention, it could be suggested that the disclosed albums correspond to the recited multimedia presentations, with at least one of the disclosed items of an album corresponding to the recited multimedia data item comprising a duplicate of a portion of the respective album. Under this interpretation, it could be suggested that the slide show feature of the Yang '586 patent corresponds to the recited display of a multimedia presentation. Thus, it could be further suggested that the Yang '586 patent discloses controlling the speed of presentation of a multimedia presentation. In no event, however, does the Yang '586 patent disclose controlling the speed of presentation of multimedia data items, as recited by the claimed invention.

C. No Motivation to Combine Contois and Yang

Presume now that one could suggest (albeit incorrectly) that the Contois '868 and Yang '586 patents did disclose respective features of the claimed invention, as alleged in the Official Action. Even in such an instance, Applicants respectfully submit that the Contois '868 and Yang '586 patents cannot possibly be combined in an attempt to obviate the claimed invention since the requisite motivation or suggestion to make the proposed modification is lacking. The Official Action does allege that one skilled in the art would be motivated to combine the Contois '868 and Yang '586 patents to "provide the capability for managing multimedia objects such as text, images, sound, and video clips." Applicants respectfully submit, however, that the Official Action appears to be applying impermissible hindsight in finding motivation to combine the Contois '868 and Yang '586 patents to disclose the claimed invention. *See In Re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (explaining that "[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure of a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight").

As stated in MPEP § 2143.01, "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)) (emphasis added). In addition, as has been held by the Board of Patent Appeals and Interferences, and noted in the MPEP, the mere fact that one skilled in the art could adapt the reference device to meet the terms of a claim is not by itself sufficient to support a finding of obviousness. The prior art or the general knowledge of one skilled in the art must also provide a motivation or reason for one skilled in the art, without the benefit of applicant's specification, to make the necessary modifications to the reference device. MPEP 2144.04(VI.)(C.) (*citing Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). Thus, Applicants respectfully submit that merely asserting that modifying the Contois '868 patent with the Yang '586 patent provides the capability for managing multimedia objects, without explaining the desirability for such a combination (without relying upon hindsight or otherwise being guided by the present application), does not by itself render obvious the claimed invention.

Applicants also question why one skilled in the art would be motivated to combine the Contois '868 patent with the Yang '586 patent to provide the capability to manage multimedia objects since the Contois '868 patent itself already includes the capability for, and is precisely configured to, manage multimedia objects.

Moreover, Applicants again return to the Official Action's interpretation of the claimed invention (but again expressly not admitted) whereby the recited multimedia presentation corresponds to the disclosed music/media information, and the recited multimedia data items correspond to either the disclosed listings or graphics presented during selection of music/media information. Under this interpretation, it should be noted that under the Contois '868 patent, these listings and graphics are generally presented in a static manner with no speed associated therewith. A user may scroll up or down to display additional listings, but the resulting presentation of the listings or graphics is static with no speed associated therewith. As such, there would be no motivation or suggestion to combine the Yang '586 patent and, in particular, the slide-show speed control described by the Yang '586 patent with the Contois '868 patent since there is no need for the control of speed in association with the presentation of the listings or graphics in the Contois '868 patent.

Applicants therefore respectfully submit that independent Claim 1, and by dependency Claims 2, 4-10 and 13-16, are patentably distinct from the Contois '868 patent and the Yang '586 patent, taken individually or in combination. The other independent claims, including independent Claims 17, 25, 27, 43, 51 and 53, include the aforementioned features of independent Claim 1, including the aforementioned feature of controlling the speed of presenting multimedia data items. Accordingly, independent Claims 17, 25, 27, 43, 51 and 53, and by dependency Claims 18-24, 26, 28, 30-36, 39-42, 44-49, 52 and 54, are patentably distinct from the Contois '868 patent and the Yang '586 patent, taken individually or in combination, for at least the same reasons as described above in conjunction with independent Claim 1.

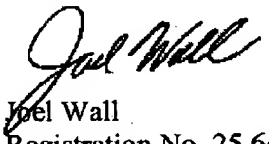
For each of the foregoing reasons, Applicants submit that Claims 1, 2, 4-10, 13-28, 30-36 and 39-49 and 51-54 are patentably distinct from any proper combination of cited references. As such, the rejection of Claims 1, 2, 4-10, 13-28, 30-36, 39-49 and 51-54 is therefore overcome.

CONCLUSION

In view of the amendments to the claims and the remarks presented above, it is respectfully submitted that the present claims are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite the examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 07-2347.

Respectfully submitted,



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